



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,098	06/20/2001	Robert Stuart Coffin	117-340	7947
23117	7590	03/23/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			LI, BAO Q	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/762,098

**Applicant(s)**

COFFIN ET AL.

Examiner

Bao Qun Li

Art Unit

1648

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

a)  The period for reply expires 6 months from the mailing date of the final rejection.

b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.  The proposed amendment(s) will not be entered because:

- (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  they raise the issue of new matter (see Note below);
- (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3.  Applicant's reply has overcome the following rejection(s): 102.

4.  Newly proposed or amended claim(s) \_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Office Action.

6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,3-5, 7-10 and 27-58.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The drawing correction filed on \_\_\_\_ is a)a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_.

Bao Qun Li

**Advisory Action**

**Due to the typographic error, the previous Office Action is vacated. A new Advisory Office Action follows:**

The response to the final action that Applicants faxed to PTO on December 29, 2003 was filed on March 04, 2004 under 37 CFR 1.116 has been entered. The response has been considered but is not deemed to place the application in condition for allowance.

For purpose of appeal, the status of the claims is as follows:

**Allowed claim(s): NONE.**

**Rejected claim (s): 1, 3-5, 7-10, 27-58.**

**Claim(s) objected to: NONE.**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1, 3-5, 7-10, 27 and 28-58 still are rejected under 35 U.S.C. 103(a) as being obvious over Speck et al. (WO 96/04395A1), Moriuchi et al. (J. Virol. 1993, Vol. 67, pp. 2739-2746) and Purewall et al. (Virology 1994, Vol. 198, pp. 385-389).
3. Applicants argue that Speck et al. teach away from the claimed invention, and neither Moriuchi et al. or Purewall et al. teach or suggest to use VP16 of another strain of herpes virus to complement the mutate VP16 human herpes simplex virus 2. Therefore the rejection should be withdrawn.
4. Applicants' argument has been respectfully considered; however, it is not found persuasive because Speck et al. teach a vector containing the mutation in the endogenous VP16 gene mutation, which is used as a vector to express an heterologous therapeutic gene and a composition comprising the vector and other pharmaceutical component.

Art Unit: 1648

5. Moriuchi et al. explicitly teach the method of using a cell line expressing the HSV VP16 homology counterpart, VZV ORF10 to rescue the VP16 mutant HSV virus, which can prompter the mutated HSV production. Purewall et al. teach other homology counterparts of HSV VP16 including EHV-1 or EHV-4, which are all able to function like HSV VP16 and strongly transactivate HSV-1 IE gene (See lines 11-32 on 2<sup>nd</sup> col. of page 387).

6. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was filled to be motivated by the cited references to propagating a VP16 and ICP4 or ICP27 double mutated HSV in a cell line transfected to express EHV-1 gene 12 with a highly expected success. Because VP16 and ICP4 double mutated virus as disclosed by Speck is able to grow well in a cell line that provide trans-complemented function of ICP4 and/or ICP27, and an additional trans complement of defective VP16 with HSV Vp16 homology such as VZV ORF10 or EHV-1 gene 12 would be able to provide a better condition for propagating this double mutated HSV. Since the claimed invention as a whole is still considered as *prima facie* obvious absence unexpected results. Therefore, the rejection is maintained.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Qun Li whose telephone number is 571-272-0906. The examiner can normally be reached on 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Qun Li

March 17, 2004

  
JAMES HOUSEL 3/22/04  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600